

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of: SCHUETZMANN et al.

Application Serial No: 10/564,625

Filing Date: October 24, 2006

Title: Security Element

Group Art Unit: 2886

Examiner: Roy M. Punnoose

Confirmation No.: 2132

Attorney Docket: 2732-172

Director of the United States
Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

In reply to the Restriction Requirement mailed June 26, 2009, please enter the following:

Remarks begin on page 2 of this paper.

REMARKS

The following remarks form a full and complete response to the Restriction Requirement dated June 26, 2009. Applicants submit pending claims 1-26 for consideration.

In response to Applicants' amendment of April 8, 2009, the Examiner reinstated the original restriction requirement. In response to the reinstated restriction requirement, Applicants elect, with traverse, Group II (directed to claims 11-17 and 25-26). Applicants traverse the restriction and submit that it is improper for the reasons that follow.

The PCT, which entered into force on January 21, 1978, governs the examination of national applications filed under it. Under the PCT, “[n]o national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.” PCT Article 27(1); see also *Caterpillar Tractor Co. v. Comm'r of Patents & Trademarks*, 650 F. Supp. 218, 220 (E.D. Va. 1986). The PCT provides a number of rules that govern the form and contents of applications. For instance, the PCT provides Rule 13 to govern unity of invention. In particular, Rule 13.1 requires that an “international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (‘requirement of unity of invention’).” PCT Rule 13.1. Under the PCT rules, the unity of invention requirement is fulfilled as follows:

[w]here a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one

or more of the same or corresponding special technical features. The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

PCT Rule 13.2 (emphasis added). In order to comply with the PCT, the U.S. Patent Office must follow the PCT rules concerning unity of invention. See *Caterpillar Tractor Co.*, 650 F. Supp. at 220 (finding rejection by the PTO of the plaintiff's application is contrary to law because it was contrary to the rules established by the PCT).

In order to comply with the requirements of the PCT, the U.S. Patent Office has, amongst other things, promulgated MPEP § 1850, which deals with the unity of invention requirement. MPEP § 1850 states, in relevant part:

when the Office considers international applications... during the national stage as a Designated or Elected Office under 35 U.S.C. § 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. § 111.

MPEP § 1850. In other words, with regard to unity of invention at least, the MPEP requires that examiners follow PCT Rules 13.1 and 13.2 for national stage applications where the United States is a Designated Office.

The determination of whether a feature of a claim constitutes a special technical feature "should be considered with respect to novelty and inventive step." See MPEP § 1850. The MPEP provides a relatively informative example of when claims do and do not have unity of invention:

Lack of unity of invention may be directly evident "a priori," that is, before considering the claims in relation to any prior art, or may only become apparent "a posteriori," that is, after taking the prior art into consideration. For example, independent claims to A + X, A + Y, X + Y can be said to lack unity a priori as there is no subject matter common to all

claims. In the case of independent claims to A + X and A + Y, unity of invention is present a priori as A is common to both claims. However, if it can be established that A is known, there is lack of unity a posteriori, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

MPEP § 1850, subsection II (emphasis added). Thus, when two or more claims share features not present in the prior art, they, *a priori*, have unity of invention.

In the present case, the Office Action cites the pertinent PCT rules (13.1 and 13.2) but fails to actually apply the proper PCT principles. Instead of looking at the features of the independent claims and determining what novel features they share, the Office Action refers only to different categories of invention. See Office Action at pp. 2-4. If the PCT rules and principles were properly applied, however, it would be clear that all of the claims share unity of invention.

Independent claims 1, 11, 18, and 20 recite a liquid crystalline material that effects (or is configured to effect, in the case of claim 20) the linear polarization of light. As discussed at length in the Amendment Applicants filed on April 8, 2009, this feature is not shown in the prior art. Since all of the independent claims recite a liquid crystalline material that effects the linear polarization of light and since this feature is not contained in the prior art, the claims have unity of invention. See MPEP § 1850 (discussing the fact that claims having "A" in common have unity of invention). Claim 22 recites corresponding special technical features relating to a method for testing an object of value. Accordingly, all of the claims have unity of invention. For this reason alone, the restriction is improper and should be withdrawn.

Applicants also note that even under the relevant U.S. standard for imposing restriction requirements, the Examiner must establish that "[t]here would be a serious

burden on the examiner if restriction is not required.” See MPEP § 803, subsection I. In the present case, all of the claims at issue have already been examined substantively by the Examiner. See Office Action dated January 9, 2009. In response to the January 9, 2009, Office Action Applicants merely amended claims 18 and 20 to incorporate features from the other independent claims. No subject matter was added to the claims that had not yet been examined by the Examiner. Applicants, therefore, fail to understand how examining all of the claims in the present application could impose a “serious burden on the examiner if the restriction is not required.” Thus, for this separate and independent reason, the restriction is improper.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the restriction requirement and pass the application to issue.

CONCLUSION

All objections and rejections have been sufficiently addressed. Applicants submit that the application is now in condition for allowance and request that the Office allow claims 1-26 and pass this application to issue.

In the event that this paper is not timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 02-2135.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

Respectfully submitted,

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